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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,814	03/07/2001	Tetsuya Yashiki	OAC-009	5757
959	7590	11/04/2005	EXAMINER	
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			BANGACHON, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. K 09/800,814	Applicant(s) YASHIKI ET AL.	
	Examiner William Bangachon	Art Unit 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner's Response

1. This Office Action is in response to the interview filed 10/20/2005 wherein the applicant argued that the finality of the last Office action is premature. Applicant's argument is persuasive and therefore the finality of the last Office action is withdrawn.

Response to Arguments

2. Applicant's arguments with respect to claims 2-24 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

3. Applicant's arguments with respect to the drawings have been fully considered and are persuasive and therefore, the objection to the drawings under 37 CFR 1.83(a) has been withdrawn.

Specification

4. Applicant's arguments with respect to the specification have been fully considered and are persuasive and therefore, the objection to the specification for failing to provide proper antecedent basis for the claimed subject matter has been withdrawn.

Claim Objections

5. Applicant's arguments with respect to claim 6 have been fully considered and are persuasive and therefore, the objection to the claim has been withdrawn.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 2-7, 10, 14-15, 18, 21, and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 2 recites the limitation "first and new security data" in page 2. Claims 3 and 5 recites the limitation "the vehicle controller". There is insufficient antecedent basis for this limitation in the claim.

9. Claim 6 provide for the **use of a new security data**, claims 10 and 18 provides for the **use of a first security data**, and claim 23 provide for the **use of a security function to authenticate an external rewriting device**, in determining whether rewriting to the rewritable memory is permitted, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

10. Claim 7 recites, "first security data that is used to determine whether rewriting to the rewritable memory is permitted". It is unclear and confusing whether the "first

security data" or the "new security data" recited in claim 6 is used to determine whether rewriting to the rewritable memory is permitted.

11. Claim 14 recites, "second security data". It is unclear and confusing whether the "second security data" or the "first security data" recited in claim 10 is used to determine whether rewriting to the rewritable memory is permitted. Further, it is unclear and confusing how the first and second security data is matched when the first security data is deleted.

12. Claim 15 recites the limitation "the second function value transferred from the rewriting device" in page 4. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 18 recites "new security data" and "first security data". There is no linking step connecting the two elements in the claim.

14. Claim 21 recites the limitation "the rewriting device" in page 5. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 24 recites both a system and the method steps of using the system. It is unclear whether the claim is directed to a machine or a process. Alternatively, the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Claim Rejections - 35 USC § 103

Art Unit: 2635

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

19. Claims 6, 8-10, 16-19, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,621,380 (Mutoh et al).

In claims 6, 8-10, 16-19, and 22-24, a memory rewriting system for a vehicle controller (as shown in Figures 1 and 2) comprising:

a vehicle controller/ECU/immobilizer (16) comprising a rewritable memory (103 or 104), the rewritable memory (103 or 104) storing second security data (ID-A) {col. 4, lines 20-28};

communication means (7, 12); and

a rewriting device (10) for storing first security data {col. 3, lines 30+}

wherein the vehicle controller is configured to;

determine whether there is a predetermined relationship between the first security data received from the rewriting device and the second security data stored in the rewritable memory {col. 4, lines 49-61; col. 6, lines 35-44};

release a security feature that prevents the rewritable memory from being rewritten if it is determined that there is the predetermined relationship there between {col. 4, lines 62+},

delete the second security data after release of the security feature (not shown);
and

write third security data received from the rewriting device, different from the first security data, into the rewritable memory, the rewriting device being suitable for additionally storing the third security data {col. 6, lines 10-17}.

Although Mutoh et al do not disclose expressly "deleting the second security data after release of the security feature", the system of Mutoh et al is capable of registering and/or updating old or lost keys {col. 5, lines 16-18; col. 6, lines 18-29}. Obviously, when

a lost key is replaced with a new key, the security data of the lost key is deleted to prevent further use of the lost key, to one of ordinary skill in the art.

Claim 18 recites the method steps of the vehicle controller and therefore rejected for the same reasons.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is (571)-272-3065. The examiner can normally be reached on 4/4/1010.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571)-272-3068. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular and After Final formal communications. The examiner's fax number is (571)-273-3065 for informal communications.

Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-6071.



William Bangachon
Examiner
Art Unit 2635

October 31, 2005

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

